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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,802	10/05/2000	Perry A. Pierce	F-209	8910

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PITNEY BOWES INC.
35 WATERVIEW DRIVE
P.O. BOX 3000
MSC 26-22
SHELTON, CT 06484-8000

EXAMINER

ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/679,802

Applicant(s)

PIERCE ET AL.

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- Claims 1, 3, 9, and 17 are amended.
- Claims 2, 11, and 19 are canceled.
- New claim 24 has been added.
- Claims 1, 3-10, 12-18, and 20-24 have been considered.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 March 2004 has been entered.

Response to Arguments

3. Applicant's arguments filed on 9 March 2004, with respect to claims 1, 3-10, 12-18, and 20-24, have been considered but are moot in view of the new ground(s) of rejection.

4. As per independent claims 9 and 17 in regards to the amended claims to incorporate a "a future date", they have been rejected under 35 USC 102(e), it would have been obvious to one having ordinary skill in the art to know that no payment possibly can occur before the date and time of the mail piece being mailed. Also it is clear that Gordon in his specification discusses that payment does take place in the future date or terminated in a future date. Gordon also references that data in the table in the figure 2 could be used to accommodate other useful dates as well (See Gordon figure 2, column 6, lines 18-32, and column 7, lines 29-52).

Double Patenting

1. Claims 1, 3-10, 12-18, and 20-24 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-22 of copending Application No. 09-679801. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: , a postage metering system, located remotely from a data center, in communication with the data center for obtaining a third party payment data via the postage metering system and coordinating the printing of an indicia on a mail piece intended for delivery to a recipient other than the addressee and dispatching payment from the data center to the payee in response to the receipt of the payment data at the data center.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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6. Claims 9-10, 12-18, and 20-23 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6289323 to Roy R. Gordon.

7. As per claims 9, and 17 Gordon discloses a payment processing method, comprising:

- locating a postage metering system remotely from a data center (See Gordon figures 4-9 and associated text);
- transmitting payment data via a postage metering system to the data center, the payment data including a payee and a payment amount (See Gordon figures 4-9 and associated text column 3, lines 6-52 and column 5 lines 29-52);
- the payment data further includes a future date on which the payment is authorized for dispatch (See Gordon figures 4-9 and associated text column 3, lines 6-52, column 5 lines 29-52, column 6, lines 18-32, and column 7, lines 29-52); and
- dispatching payment from the data center to the payee for the payment amount in response to the receipt of payment data and the occurrence of the future date (See Gordon figures 4-9 and associated text column 3, lines 6-52, column 5 lines 29-52, column 6, lines 18-32, and column 7, lines 29-52).

8. As per claims 10, and 18, Gordon discloses all the limitations of claims 9, and 17, further;

Gordon discloses,

- coordinating printing by the postage metering system of an indication of the third party payment on a mail piece intended for delivery to the payee (See Gordon figures 4-9 and associated text column 2, lines 31-40, column 3, lines 6-65 and column 5 lines 29-52).

9. As per claims 12, and 20, Gordon discloses all the limitations of claims 11, and 19, further;

Gordon discloses,

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- the third party payment indication includes a digital signature of a least a portion of the payment data so that any attempts to tamper with the payment data are detectable (See Gordon figures 4-9 and associated text column 2, lines 5-16, column 4, lines 8-43).

10. As per claims 13, Gordon discloses all the limitations of claims 12, further;

Gordon discloses,

- the mail piece is a business return mail piece provided by the payee, the business return mailpiece including space to receive the indication of the third party payment. (See Gordon figures 8 and 9 and associated text, column 14 lines 55, 64).

11. As per claims 16, and 23, Gordon discloses all the limitations of claims 15, and 22, further;

Gordon discloses,

- the payment data further includes a date on which the payment is authorized for dispatch (See Gordon figures 4-9 and associated text column 3, lines 6-65, column 5 lines 29-52 and column 7, lines 36-53).

12. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6289323 to Roy R. Gordon in view of U.S. Patent No. 6,427,021 in view of U.S. Patent No. 6,427,021 to Meredith B. Fischer.

13. As per claims 1, Gordon discloses a payment processing system and method, comprising:

- a data center (See Gordon figures 4-9 and associated text);
- a postage metering system located remotely from the data center (See Gordon figures 4-9 and associated text); and
- a control system in operative communication with the data center and the postage metering system (See Gordon figures 4-9 and associated text column 3, lines 6-52 and column 5 lines 29-52), the control system for:
 - obtaining payment data via the postage metering system, the payment data including a payee and a payment amount (See Gordon figures 4-9 and associated text column 3, lines 6-65 and column 5 lines 29-52); and
 - dispatching payment from the data center to the payee for the payment amount (See Gordon figures 4-9 and associated text column 3, lines 6-65 and column 5 lines 29-52).

What is not clear in disclosure of Gordon is that it is not clear if there is a third party payment other than the vendor. However, Fischer clearly discloses the steps of a Postal Authority payment of a sum to a third party other than the entity that the mail piece is addressed to (See Fischer figure 3 and 16 and associated text, column 5, lines 9-28, column 6, lines 26-48, and column 11, lines 40-64). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the two concepts to integrate multiple payments in single mail piece to consolidate payments and expedite the process.

14. As per claim 3, Gordon and Fischer disclose all the limitations of claim 2, further; Gordon discloses,

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- the payment data further includes a future date on which the payment is authorized for dispatch (See Gordon figures 4-9 and associated text column 3, lines 6-65, column 5 lines 29-52 and column 7, lines 36-53).

15. As per claim 4, Gordon and Fischer disclose all the limitations of claim 3, further;

Gordon discloses,

- the third party payment indication includes a digital signature of a least a portion of the payment data so that any attempts to tamper with the payment data are detectable (See Gordon figures 4-9 and associated text column 2, lines 5-16, column 4, lines 8-43).

16. As per claim 5, Gordon and Fischer disclose all the limitations of claim 4, further;

Gordon discloses,

- the mail piece is a business return mail piece provided by the payee, the business return mailpiece including space to receive the indication of the third party payment. (See Gordon figures 8 and 9 and associated text, column 14 lines 55, 64).

17. As per claim 8, Gordon and Fischer disclose all the limitations of claim 7, further;

Gordon discloses,

- the payment data further includes a date on which the payment is authorized for dispatch (See Gordon figures 4-9 and associated text column 3, lines 6-65, column 5 lines 29-52 and column 7, lines 36-53).

18. As per claim 24, Gordon and Fischer disclose all the limitations of claim 1, further;

Gordon is not explicit on this step of the process, even though one skilled in the art would have been inclined to know that a system like Gordon's is not designed for generating one mail piece at a time and obviously it is used for multiple number of mail pieces. ,

- The indication of the third party payment is printed on a plurality of mailpieces intended for delivery to a plurality of mailpiece recipients other than the payee .

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payment value or indicia to be run concurrently to save time and be more efficient in possessing the same.

19. Claims 6, 7, 14, 15, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6289323 to Roy R. Gordon.

20. As per claims 6, 7, 14, 15, 21, and 22, Gordon and Fischer disclose all the limitations of claims 1, 5, 9, 17, 13, and 20, further;

21. What Gordon is not clear is if the value payments from multiple payers are aggregated before they are forwarded to be credited to the payee's account. Gordon discloses the aggregation of collected mail pieces and the forwarding them to the end user. Although, Gordon discloses the claimed invention, as discussed above, except for the step of collecting payments from a plurality of postage metering systems that are directed to the payee before dispatching an aggregated payment to the payee. It would have been an obvious matter of design choice to modify the teachings of Gordon, to provide the step of collecting payments from a plurality of postage metering systems that are directed to the payee before dispatching an aggregated payment to the payee. Since applicant has not disclosed that solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Gordon will perform the invention as claimed by the applicant with any method, means or product to collecting payments from a plurality of postage metering systems that are directed to the payee before dispatching an aggregated payment to the payee (See Gordon figure 9 and its associated text and column 15, lines 59-68).

22. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response,

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to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

24. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington D.C. 20231**

or faxed to:

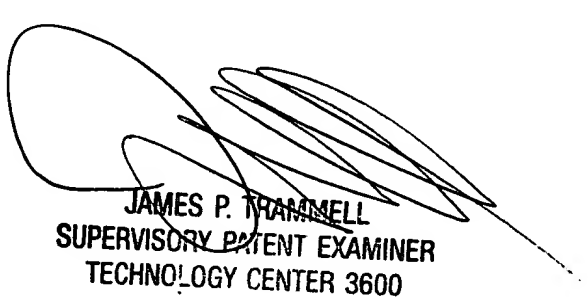
(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

**Abdi/K
April 29, 2004**


**JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**